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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/665,536 | 09/22/2003 | Tetsuro Motoyama | 241505US CIP | 5927 |
| 22850 | 7590 | 06/22/2007 | | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER | |
| | | | CHANKONG, DOHM | |
| ART UNIT | | PAPER NUMBER | | |
| 2152 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 06/22/2007 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/665,536 | MOTOYAMA, TETSURO |
| | Examiner | Art Unit |
| | Dohm Chankong | 2152 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/23/04, 10/20/04, 10/26/05, 12/12/05, 5/1/06, 6/27/06, 8/18/06, 1/10/07.

DETAILED ACTION

1. Claims 1-28 are presented for examination.

Information Disclosure Statement

2. The information disclosure statements filed on (all in 2004) February 13, March 2, March 9, March 22, March 29, April 9, May 4, June 1, June 14, June 22 and April 14, 2005 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they fail to provide: the application number of the application in which the IDS is being submitted (37 CFR 1.98(a)(1)(ii)) and a column that provides a space, next to each document to be considered, for the examiner's initials (37 CFR 1.98(a)(1)(ii)).

They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either

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anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-28 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-20 of U.S. Patent No. 6,631,247 ['247 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broadly written versions of the '247 patent claims.

Claim 1 of the instant application recites a network device that transmits a message to a first computer, the first computer then transmitting a communication comprising the message to a second computer. Claim 1 of the '247 patent recites a network device transmitting a message to a first computer, the first computer transmitting a communication comprising the message to a second computer. The only difference between the claims is that claim 1 of the '247 patent claims that the second computer is local to the network device.

However, as claim 1 of the instant application does not have any limitation as to the location of the second computer, this difference does not render the claims

patentably distinct. Claim 1 of the instant application is merely broader than claim 1 of the '247 patent. As to the dependent claims, they are also substantially similar. Therefore, claims 1-28 are rejected on the ground of nonstatutory obviousness-type double patenting.

4. Claims 1-28 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-20 of U.S. Patent No. 6,714,971 ['971 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broadly written versions of the '971 patent claims.

Claim 1 of the instant application recites a network device that transmits a message to a first computer, the first computer then transmitting a communication comprising the message to a second computer. Claim 1 of the '971 patent recites a first device transmitting a message to a first computer, determining whether the message should be forwarded in a communication and transmitting this communication from the first computer to a first end user. The only difference here being that claim 1 of the '971 patent recites a "first end user" rather than a second computer. But this is simply a variation in terminology because it is clearly implied that the first end user accesses the communication from a computer; therefore, a first computer is still transmitting a computer to a second computer.

5. Claims 1-28 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of

copending Application No. 10/423,983 ['983 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broadly written versions of the '983 application claims.

Like the '971 patent, claim 1 of the '983 patent recites a first device transmitting a message to a first computer, determining whether the message should be forwarded as a communication (information regarding a first end user) and transmitting this communication from the first computer to the first end user. The only difference being one of terminology, these claims are analogous to the claims of the instant application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-28 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/638,540 ['540 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broadly written versions of the '540 application claims.

Claim 1 of the '540 application recites a network device transmitting a message to a service center computer with the service center computer transmitting a communication to a resource administration computer. Like the previous patent and applications, the only differences between the claims of the '540 application and the instant application are merely semantic. The differences in terminology do not

change the fact that the functionality is the same: a first device transmitting a message to a second device, the second device analyzing the message for a communication and the second device transmitting the communication to a third device. The claims of this instant application are written even more broadly than those here. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's specification does describe or explain what is meant by claiming that the second computer is "local" to the network device. There are a variety of plausible interpretations such as the second computer is within the same device as the network or that the second computer is located on the same network as the network device. Because of the variety of interpretations and the fact that the specification is silent as to how this limitation should properly be interpreted, claim 20 is rejected for

containing subject matter not described in the specification to reasonably convey that the inventor had possession of the claimed invention.

For the purposes of this action, this limitation will simply be interpreted as the second computer is “local” to the network device when the second computer is in same network as the network device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 are rejected under 35 U.S.C §102(e) as being anticipated by Anderson et al, U.S Patent Publication No. 2002/0091944 (“Anderson”).

9. As to claim 1, Anderson discloses a method of processing messages, comprising:

transmitting a message from a network device to a first computer that is remote from said network device, said message including information obtained from sensors of the network device [Figure 1 «items 100, 114» | 0030, 0032, 0058 : network enabled devices (servers, printers) configured to communicate status over the

network to a central information system. Anderson's network enabled device is analogous to a network device; Anderson's central information system is analogous to a first computer];

receiving the message by the first computer [0032];

determining, by the first computer, if a communication containing at least part of the message, including at least some of the information obtained from the sensors, is to be transmitted from the first computer to a second computer [Figure 1 | 0034, 0041 where : Anderson's central information system determines whether to notify the staff or customer through the web server 118. Anderson's web server 118 is analogous to a second computer];

transmitting the communication from the first computer to the second computer in response to the determination made by the first computer [0033, 0034]; and

receiving said communication by the second computer [0033, 0034].

10. As to claim 2, Anderson discloses the message comprises information regarding usage of the device [0041 : server running out of disk space analogous to usage of the device].

11. As to claim 4, Anderson discloses the communication generated by the first computer comprises an Internet electronic mail message [0034].

12. As to claim 6, Anderson discloses:

generating, by the first computer, the communication to include summary

information regarding usage of the device [0034, 0051];

wherein the step of transmitting the communication from the first computer comprises transmitting, by the first computer, the communication that includes the information regarding usage of the device to the second computer [0034, 0051].

13. As to claims 7 and 8, Anderson discloses the network device is a business office device, wherein the business office device is at least one of a printer, a copier, and a facsimile machine [0030].

14. As to claim 9, Anderson discloses transmitting said message from the network device to the first computer without going through the second computer [Figure 1 «items 100, 114, 118» where : the enterprise device sends message directly to the central information system, without going through the customer's web server].

15. As to claim 10, Anderson discloses transmitting a message from the network device to the second computer, said message including said information obtained from the sensors of the network device [0032-0034, 0041, 0058 where : the network device sends messages to the central system which then emails the message to the customer's server. The email contains status information from the sensors of the device. Sensor also implied by the server "sensing" that it has run out of disk space].

16. As to claims 11, 12, 14 and 16-20, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 1, 2, 4 and 6-10, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 3 and 5 are rejected under 35 U.S.C §103(a) as being unpatentable over Anderson, in view of Kawashima, U.S Patent Publication No. 2003/0018780.

18. As to claim 3, Anderson does disclose that the device sends messages to the first computer Anderson does not expressly disclose the message comprises an Internet electronic mail message. Sending emails containing status information from a monitored device to a monitoring device is well known in the art. For example, Kawashima discloses a system whereby monitored devices use messages such as email to send usage information to monitoring computers [abstract, 0062 : paper, paper jam, out of toner].

Based on Kawashima, one of ordinary skill in the art would have reasonably

modified Anderson's messaging (from the network device to the first computer) to include email functionality. Email functionality has several benefits including the ability submit usage information when no response is required from the receiving party [see Kawashima, abstract].

19. As to claim 5, Anderson discloses the communication generated by the first computer comprises an Internet electronic mail message [0034]. Anderson does not expressly disclose the message comprises an Internet electronic mail message. See rejection of claim 3.

20. Claims 21, 22 are rejected under 35 U.S.C §103(a) as being unpatentable over Anderson.

21. As to claim 21, Anderson discloses a method of monitoring at least one network device communicatively coupled to a local network, comprising:
accessing the at least one network device by a service center computer that is remote from said local network to obtain device status information of the at least one network device, including information obtained from sensors of the at least one network device [0007, 0017, 0041, 0058, 0070 where : on request, the system queries the status of the enterprise devices];

storing the obtained device status information [0038];
periodically processing the stored status information to generate a usage report for the at least one network device [0033, 0034, 0051 : forming notifications based on

the status information. Anderson does not expressly disclose a usage report, however, he does describe generating email notifications which one of ordinary skill in the art could reasonably infer to be analogous to a usage report];

transmitting the usage report from the service center computer to a second computer [0033, 0034, 0051]; and

receiving the usage report by the second computer [0033, 0034, 0051].

22. As to claim 22, Anderson discloses transmitting the usage report from the first computer to the second computer as an e-mail message, wherein said email message is transmitted at an application layer [0034].

23. As to claim 24, Anderson discloses:

translating the usage report into a format suitable for display on a web page [0033, 0051]; and

receiving a request for transmission of the usage report from the second computer [0042, 0043 : a customer generating a request for a status report for each device].

24. As to claims 25, 26 and 28, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 21, 22 and 24, respectively.

25. Claims 23 and 27 are rejected under 35 U.S.C §103(a) as being unpatentable over Anderson, in view of Levi et al, U.S Patent No. 6.477.667 ["Levi"].

26. As to claims 23 and 27, Anderson does disclose transmitting data from the first computer to the second computer but does not expressly disclose transmitting data as a facsimile message. Sending reports by fax is well known in the art.

For example, Levi is directed towards a system for monitoring remote devices. Levi expressly discloses that usage reports can be sent to administrators by fax [Figure 1 «item 36» | column 2 «lines 42-44» | column 4 «lines 32-41»]. It would have been obvious to one of ordinary skill in the art to incorporate fax capability into Anderson's system to increase the communications functionality of the system.

Adding fax capability increases the number of options where a customer or staff can be notified of important information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Barrett, U.S Patent No. 5.852.746;

Fan et al, U.S Patent No. 6.310.692;

Sekizawa, U.S Patent No. 6.430.711;

Abel et al, U.S Patent Publication No. 2003/0043401;

Cravo De Almeida et al, U.S Patent Publication No. 2003/0055931;

Grinter et al, U.S Patent No. 6.606.304;

Mukaiyama et al, U.S Patent No. 6.631.407;

Tameda et al, U.S Patent Publication No. 2003/0200308;

Ishimoto, U.S Patent Publication No. 2003/0229691;

Katagiri et al, U.S Patent No. 6.907.551;

Mukaiyama et al, U.S Patent No. 6.970.923;

Palmer et al, U.S Patent No. 6.981.015;

Lovy et al, U.S Patent No. 7.028.228;

Yamaguchi et al, U.S Patent No. 7.035.900;

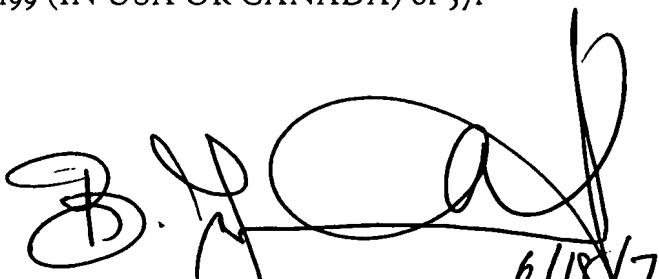
Hansen, U.S Patent No. 7.117.239.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



6/18/17

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER